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Kenneth J. Waite  
ROCHE DIAGNOSTICS CORPORATION  
9115 Hague Road, Building D  
P.O. Box 50457  
Indianapolis, IN 46250-0457

In re Application of  
BIRYUKOV, Sergey, Vladimirovich, et al.  
U.S. Application No.: 09/937,474  
PCT No.: PCT/EP00/02508  
International Filing Date: 22 March 2000  
Priority Date: 25 March 1999  
Attorney's Docket No.: RDID01051US  
For: METHOD FOR SYNTHESIS OF POLY-  
PEPTIDES IN CELL-FREE SYSTEMS

COMMUNICATION  
REGARDING SUBMISSION  
UNDER 37 CFR 1.42

This communication is issued in response to applicants' submission on 15 August 2002 of a declaration executed on behalf of the deceased inventor, which has been treated as a submission under 37 CFR 1.42.

### **BACKGROUND**

On 22 March 2000, applicants filed international application PCT/EP00/02508 which claimed a priority date of 25 March 1999 and which designated the United States. On 05 October 2000, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

The deadline for payment of the basic national fee was 25 September 2001 (thirty months from the priority date).

On 25 September 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 26 February 2002, the USPTO mailed a Notification Of Missing Requirements requiring submission of an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date. The Notification set forth an extendable two-month deadline.

On 15 August 2002, applicants filed a response to the Notification Of Missing Requirements, accompanied by payment for a four month extension of time. The response included payment of the required surcharge, a declaration executed by the three surviving applicants and by Alena Simonenko, and a separate document entitled "Signature By

Administrator On Behalf Of Deceased Inventor” in which Alena Simonenko sets forth her residence and citizenship and states that she executed the accompanying declaration on behalf of the deceased inventor Peter Simonenko as his Administrator.

### DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

37 CFR 1.497(b)(2) requires that the declaration include citizenship, mailing address, and residence information for **both** the deceased inventor and the legal representative. The regulation expressly requires the inclusion of this information for the legal representative. As for the deceased inventor, such information is required because the legal representative must declare to all the facts which the inventor would have been required to state, and citizenship, residence and mailing address are among the facts which the inventor would have been required to set forth pursuant to 37 CFR 1.497(a) and 37 CFR 1.63. 37 CFR 1.497(b)(2) also requires that the declaration expressly state the relationship to the deceased of the person signing on his behalf.

Here, the declaration submitted on 15 August 2002 was executed by Alena Simonenko on behalf of the deceased inventor Peter Simonenko, and the declaration includes the required residence and citizenship information for the deceased inventor. However, the declaration itself does not state Alena Simonenko's relationship to the deceased inventor, nor does it include her citizenship and residence information. As noted above, this information is contained in the separate "Signature By Administrator On Behalf Of Deceased Inventor" filed by applicants with

the declaration. However, this separate statement is not part of the actual declaration and is not itself executed as a declaration in compliance with 37 CFR 1.68. Accordingly, this information cannot be treated as having been included in the declaration, as required by 37 CFR 1.497(b)(2).

Based on the above, the declaration filed 15 August 2002 does not provide all the information required by 37 CFR 1.497(b)(2) and therefore cannot be accepted under 37 CFR 1.42.

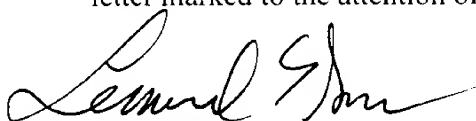
### CONCLUSION

The 15 August 2002 submission under 37 CFR 1.42 is **REFUSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this communication to submit a proper response under 37 CFR 1.42 and 37 CFR 1.497. Failure to provide a proper and timely response will result in abandonment.

A proper response must include an acceptable declaration properly executed under 37 CFR 1.42, that is, a declaration executed on behalf of the deceased inventor by the proper party under 37 CFR 1.42 and including all the information required by 37 CFR 1.497, as discussed above.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard Smith  
PCT Legal Examiner  
PCT Legal Office

RMR/LS:rnr



Richard M. Ross  
PCT Petitions Attorney  
PCT Legal Office  
Telephone: (703) 308-6155  
Facsimile: (703) 308-6459